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No. 95-127

In The

Supreme Court of the United States

October Term, 1995

VAN KLASSENS, INC.
AND
ROBERT LUKINGBEAL,

Petitioners,

v.

IMAGINEERING, INC.,

Respondent.

Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION OF PASS & SEYMOUR, INC. TO FILE AN AMICUS CURIAE BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI AND AMICUS CURIAE BRIEF

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MOTION FOR LEAVE TO FILE BRIEF AND BRIEF OF PASS & SEYMOUR, INC., AS AMICUS CURIAE IN SUPPORT OF THE PETITION

Pass & Seymour, Inc., (hereinafter "Pass & Seymour") hereby moves, pursuant to Rule 37.2 of the Rules of this Court, for leave to file the attached Brief Amicus Curiae in support of the Petition for Certiorari. Counsel for Van Klassens, Inc., and Robert Lukingbeal (hereinafter collectively "Van Klassens") has consented to the filing of this brief. A copy of the consent letter is filed concurrently with the Clerk of the Court. However, counsel for the Respondent has withheld consent.

Pass & Seymour is a manufacturer of electrical plugs and connectors, some of which have been designed based in part upon expired patents previously held by other companies. On

or about October 20, 1994, Hubbell Incorporated (hereinafter "Hubbell"), another manufacturer of electrical plugs and connectors, filed a complaint in the United States District Court for the Southern District of New York (Civil Action No. 94 CIV. 7631) alleging, *inter alia*, that Pass & Seymour had infringed the trade dress rights of Hubbell in product configurations for plugs and connectors.

Upon review of the underlying facts, it was discovered that Hubbell had been granted two design patents for plugs and connectors identical or similar to the alleged product configuration trade dress on which Hubbell based its claims against Pass & Seymour. In addition, it was found that Hubbell had been granted a utility patent for plugs and connectors in which the "best mode" for practicing the invention recited a product configuration substantially similar to that at issue before the District Court. It was further determined that both of the design patents and the utility patent had expired.

Pass & Seymour subsequently filed a Motion to Dismiss the trade dress portion of Hubbell's case based upon the decisions of this Court in *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite*, 376 U.S. 234 (1964); and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), among others. While Pass & Seymour's Motion to Dismiss was under advisement, this Court issued its decision in *Qualitex Co. v. Jacobson Products Co., Inc.*, __ U.S. __, 115 S.Ct. 1300 (1995). That decision and the relevant language therein relating to the public domain status of the subject matter of expired patents was brought to the attention of the District Court by Pass & Seymour.

Despite the precedents of this Court, the District Court in *Hubbell* ruled that Hubbell could claim trade dress rights in a product configuration which was the subject matter of expired design and utility patents. During the course of that decision, the District Court indicated that the discussion by this Court in

Qualitex regarding the public domain status of expired patents was ambiguous and might not apply to expired design patents. The initial decision of the District Court in the *Hubbell* action forms part of the appendix to the Brief of Pass & Seymour.

In a subsequent order, the District Court refused to certify the product configuration issue to the Second Circuit. A copy of that decision is also in the appendix to the Brief of Pass & Seymour.

Due to decisions such as that of the District Court in the *Hubbell* action, Pass & Seymour, along with many other companies, can no longer rely upon the "public domain" status of expired or invalidated patents in making decisions regarding the design and manufacture of products. The decision of the United States Court of Appeals for the Federal Circuit in *Van Klassens, Inc. v. Imagineering, Inc.*, presents a situation parallel to that faced by Pass & Seymour in the *Hubbell* action. A determination by this Court that *Imagineering* was wrongly decided by the Federal Circuit would likely lead to the dismissal of all of Hubbell's trade dress claims against Pass & Seymour.

In short, the issues raised by Petitioners affect directly the vital interests of Pass & Seymour in the action brought by Hubbell before the United States District Court for the Southern District of New York. Petitioners' assertions and this Court's treatment of those assertions will also affect the future ability of Pass & Seymour and others to determine whether they may rely upon the subject matter of expired or invalidated patents in bringing products to the marketplace.

For these reasons, Pass & Seymour respectfully requests leave to file the attached brief, and urges this Court to grant Van Klassens' Petition and reverse the decision below.

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Ignoring or circumventing the precedents of this Court in the trade dress field[1] has been characterized in a recent decision of the Tenth Circuit as "a veritable jurisprudential art form in recent years." *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 35 USPQ2d 1332, 1337 (10th Cir. 1995) and cases cited therein. This revolt among a number of lower courts has

[1] *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938); *Sears, Roebuck & Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Bonito Boats v. Thundercraft Boats, Inc.*, 489 U.S. 141 (1989).

taken place despite the clear dictates of the Constitution, the patent statute and the precedents of this Court, all of which require that unpatented creations in the sciences and useful arts remain in the public domain, free for all to use. Art. I, Sec. 8, Cl. 8; *See* 35 U.S.C. §§ 154, 173.[2]

The Founding Fathers strongly believed that progress of science and the useful arts depends upon restricting the duration of protection for patentable products to "limited times." U.S. Const., Art. I, Sec. 8, Cl. 8. This formula of limited protection is necessary to prevent perpetual monopolies of inventions. *Graham v. John Deere Co. of Kansas City, supra; Merchant & Evans v. Roosevelt Bldg. Products*, 963 F.2d 628, 633 (3rd Cir. 1992). The patent system incorporates this idea and further requires that patent protection be afforded only when a product is both novel and non-obvious to a person skilled in the particular field of the alleged invention (often referred to as one "skilled in the art")[3]. If a product is not novel or is obvious (in light of prior patents or material in the public domain) to one "skilled in the art," then the product may not be protected by patent and, like the subject matter of expired or invalidated patents, is free for all to use. 35 U.S.C. §101 *et seq.*

This Court has consistently ruled that common law precepts of unfair competition and state statutes that seek to protect

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[2] The right to imitate industrial products is essential to free and fair competition. *American Safety Table Co., Inc. v. Schreiber*, 269 F.2d 255, 271-272 (2d Cir.), *cert denied*, 361 U.S. 915 (1959) ("[I]mitation is the life blood of competition. It is the unimpeded availability of substantially equivalent units that permits the normal operation of supply and demand to yield the fair price society must pay for a given commodity...Unless such duplication is permitted, competition may be unduly curtailed with the possible result of development of undesirable monopolic conditions."); *Graham v. John Deere Co. of Kansas City*, 282 U.S. 1,6 (1966) (Congress "may not create patent monopolies of unlimited duration.")

[3] *See Bonito Boats*, 489 U.S. at 148 and 150; *Lon Tai Shing Co, Ltd. v. Koch + Lowy*, 19 USPQ2d 1081, 1105 (S.D.N.Y. 1990).

designs must give way to the goals of the patent clause of the Constitution and the federal statutes which implement it[4]. In fact, were the claims of Imagineering in the current action based solely upon state law, those assertions should not have survived a motion to dismiss since this Court has unequivocally held that the subject matter of an invalidated design patent is incapable of forming the basis for common law or other State claims for unfair competition. *See, Sears, supra*; *Compco, supra*.

The lower courts have finessed this situation by placing reliance on Section 43(a) of the Trademark Act of 1946 (As Amended) (15 U.S.C. §1125(a)) for their recent grants of unlimited protection to product configurations. *See Brunswick Corp v. Spinit Reel Co.*, 832 F.2d 513 (10th Cir. 1987); *Kohler Co. v. Moen, Inc.*, 12 F.3d 632 (7th Cir. 1993). However, Section 43(a) was never intended to usurp the role of the patent clause of the Constitution or its implementing legislation. The original intent of Section 43(a) was to prevent the use of false designations of geographic origin. *Vornado*, 35 USPQ2d at 1335. Solely through judicial interpretation, that statute has become a federal common law of unfair competition. *Id.* The broad interpretation of a statute originally narrowly drawn to address a particular limited wrong (false geographic indications of origin) is hardly a compelling basis on which to overturn the intent of the framers of the Constitution or the specific limitations placed on protection of inventions by the patent law. 35 U.S.C. §101 *et seq.*; *See Vornado, supra*; John B. Pegram "Trademark Protection of Product and Container Configurations," 81 *The Trademark Reporter*, 1 (1991) (hereinafter "Pegram") and Melissa R. Gleiberman, Note, "From Fast Food to Fast Cars: Overbroad Protection of Product Trade Dress Under Section 43(a) of the Lanham Act," 45 Stan.L.Rev. 2037 (1993) (hereinafter "Gleiberman").

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[4] Note 1, *supra*

The lower courts which have circumvented this Court's *Sears/Compco* line of precedents have largely ignored the ***result*** which those decisions sought to prevent (i.e. a perpetual monopoly in product configurations otherwise in the public domain), in favor of permitting trade dress protection based upon the difference in the ***process*** for determining patent and trademark infringement and different ***goals*** of the patent and trademark systems[5]. However, after *Bonito Boats*, scholars began to note that the lower courts were permitting precisely what this Court has consistently sought to prevent — a restraint on fair competition in the form of trade dress protection for product configurations that is potentially infinite in duration[6].

Some lower courts have begun to appreciate the perniciousness of allowing monopolies in product configurations outside the patent system[7]. For example, the Court of Appeals for the Federal Circuit has twice held that the use of a

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[5] *See, Brunswick, supra; Kohler, supra.*

[6] *See Pegram, supra; Gleiberman, supra.*

[7] The tendency of lower courts to ignore or circumvent the past decisions of the Supreme Court in this field may be based upon their desire to create a United States' counterpart for European-style industrial design law. However, it is clear that the United States does not currently have an industrial design statute. *Bonito Boats*, 489 U.S. at 167-68; *See* S.791 (DeConcini), H.R. 1179 (Moorhead), 100th Congress, 1st Sess. (1987) and Hearings on S.791 Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary, 100th Cong., 1st Sess. (1987). This court has recognized that "[a] federal decision to forego regulation in a given area may imply an authoritative federal determination that the area is best left unregulated, and in that event would have as much pre-emptive force as a decision to regulate." (emphasis in original)(quoting with approval *Arkansas Electric Cooperative Corp. v. Arkansas Public Service Comm'n*, 461 U.S. 375, 384 (1983)). Therefore, the fact that Congress has decided to forego industrial design protection and has limited patent terms to a fixed number of years is substantial support for the position that this Court has historically taken in refusing to use the vehicle of unfair competition law to grant perpetual protection to product configurations.

defendant's trademark on its goods may be sufficient to dispel a likelihood of confusion in trade dress actions[8]. *Conopco, Inc. v. May Department Stores Company*, 32 USPQ2d 1225 (Fed. Cir. 1994), *cert denied*, __ U.S. __ (1995); *L.A. Gear v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir.), *cert. denied* __ U.S. __, 114 S. Ct. 291 (1993); *see Wallace International Silversmiths, Inc. v. Godinger Silver Art Co, Inc.*, 916 F.2d 76, 80 (2nd Cir. 1990), *cert denied*, 499 U.S. 976 (1991). The Tenth Circuit has gone further by holding that some product configuration trade dress actions must be barred based upon the unavoidable conflict which such protection would created with the goals of the patent system. *Vornado, supra*. The Third Circuit has approached the issue somewhat differently, but with the same result, by questioning whether the approach used in determining trademark infringement is appropriate where product configurations are at issue. *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431 (3rd Cir. 1994); *Versa Products Co., Inc. v. Bifold Co.*, 50 F.3d 189 (3rd Cir. 1995).

The recent return by some lower courts to the principles of *Sears, Compco* and *Bonito Boats* has lead to conflicts among the Circuits. (compare: *Kohler, supra* with *Vornado, supra*[9]; *Duraco* and *Versa* with *Stuart Hall Co., Inc v. Ampad Corp*, 34 USPQ2d 1428 (8th Cir. 1995)).

With the advent of this Court's decision in *Qualitex Co. v. Jacobson Products Co., Inc.*, __ U.S. __, 115 S.Ct. 1300 (1995), it seemed that the matter of overbroad-protection for product configurations should have been laid to rest. In *Qualitex*, the unanimous Court used an example drawn from patent law to illustrate the point that certain configurations are per se func-

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[8] Likelihood of confusion is the standard for assessing trade dress infringement. *Two Pesos, Inc. v. Taco Cabana, Inc.*, __ U.S. __, 1125 S.Ct. 2753 (1992).

[9] The dissent in *Kohler*, 12 F.3d at 644-651 (Cudahy, J. dissenting) follows much of the reasoning in *Vornado, supra*.

tional, no matter whether the basis asserted for protection is state or federal unfair competition law:

> It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited period of time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever.... Functionality doctrine therefore would require, to take an imaginary example, that even if customers have come to identify the special illumination-enhancing shape of a new patented light bulb with a particular manufacturer, the manufacturer may not use that shape as a trademark, for doing so, after the patent had expired, would impede competition — not by protecting the reputation of the original bulb maker, but by frustrating competitors' legitimate efforts to produce an equivalent illumination-enhancing bulb. *See e.g., Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119-120 (1938) (trademark law cannot be used to extend monopoly over the "pillow" shape of shredded wheat biscuit after the patent for that shape had expired).

Qualitex, 115 S.Ct. at 1304.

However, within weeks of the *Qualitex* decision, one district court had already determined that the quoted language was ambiguous and did not prevent trade dress protection for a product configuration that had been the subject of two expired design patents and one expired utility patent. *Hubbell Incorporated v. Pass & Seymour, Inc.*, 94 Civ. 7631, Opinion May 18, 1995, pp. 10-12 (attached as Appendix A) and *Hubbell Incor-*

porated v. Pass & Seymour, Inc., 94 Civ. 7631, Opinion, August 3, 1995 (attached as Appendix B). The *Hubbell* decision illustrates a simple and unfortunate fact: that despite a century of decisions by this Court holding that monopolies in product configurations cannot endure beyond the "limited terms" specified by the Constitution and the patent law, some lower courts continue to ignore or circumvent those clear precedents. The exceptions created by the lower courts make adoption of product configurations hazardous for businesses that rely upon the plain meaning of the patent law, which specifies that the subject matter of expired or invalid patents is free for all to use.

Conclusion

The Constitution's requirement of "limited terms" for patent protection was intended to inject some certainty into the process of competition. The bedrock of that commercial certainty is the principal that patented subject matter which enters the public domain by means of patent expiration or invalidation is free for all to use. That basic principal has been seriously and, from the standpoint of free and fair competition, dangerously eroded by decisions such as that in *Imagineering*. The decisions of the Tenth and Third Circuits in *Vornado, supra, Duraco, supra* and *Versa, supra* stand in clear contrast to the holding in *Imagineering* and demonstrate that a conflict exists among the Circuits on this issue.

There is a compelling need for this Court to inject certainty and consistency into the field of product configuration protection by clearly holding that the subject matter of expired or invalidated patents cannot be resurrected through either the state or federal law of unfair competition into a perpetual monopoly on that which should rightfully be in the public domain. For this reason, it is respectfully submitted that the petition for writ of certiorari submitted on behalf of Van Klassens Inc. and Robert Luckingbeal should be granted.

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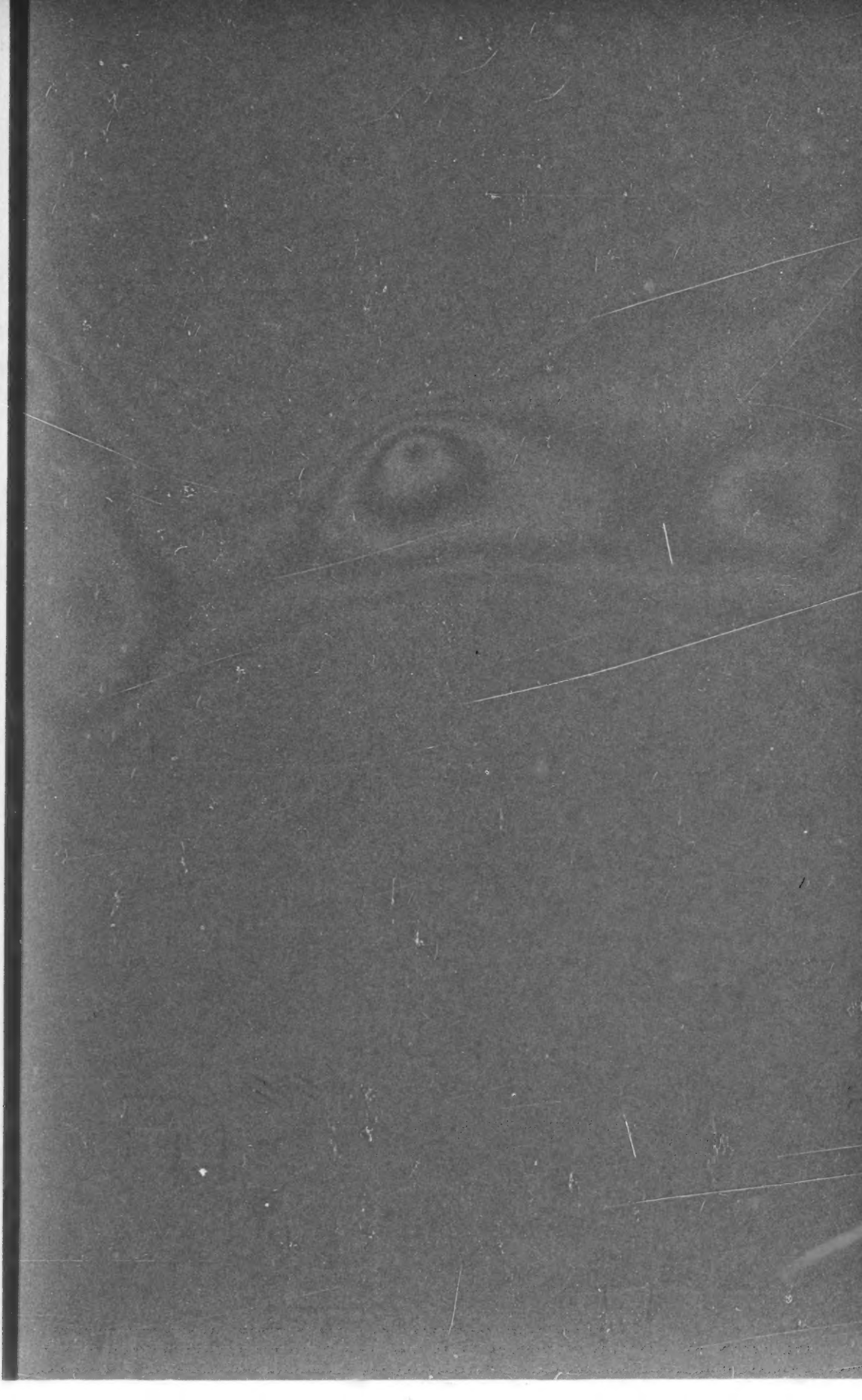

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

HUBBELL INCORPORATED,

Plaintiff,

- against -

PASS & SEYMOUR, INC. and
LEGRAND, S.A.,

Defendants

OPINION
94 Civ. 7631 (RWS)

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Sweet, D.J.

Defendants Pass & Seymour ("Pass") and Legrand S.A. ("Legrand") have moved to dismiss the federal and common law trade dress claims of Plaintiff Hubbell Incorporated ("Hubbell") pursuant to Fed. R. Civ. Pro. 12(b)(6). In addition, Legrand has moved to dismiss the action against it for lack of subject matter jurisdiction, lack of personal jurisdiction and lack of venue. In the alternative, Legrand moves for a change of venue to the Northern District to New York. Pass moves to dismiss the action for lack of venue pursuant to 12(b)(3) or, in the alternative, to transfer the claims to the Northern District of New York. Hubbell has moved to dismiss Count II of Pass' counterclaim (International Interference with Business Relationships) pursuant to Rule 12(b)(6). For the reasons set further below, all motions are denied.

The Parties

Plaintiff Hubbell is a Connecticut corporation that manufacturers electrical products. Its principal place of business is at 584 Derby Milford Road, Orange, Connecticut.

Defendant Pass is a New York Corporation doing business in the State of New York and within this judicial district, having its principal place of business at P.O. Box 4822, Syracuse, New York.

Defendant Legrand is a corporation organized and existing under the laws of the country of France.

Prior Proceedings

A complaint was filed in this action on October 20, 1994 (the "original complaint") and was later amended on December 14, 1994. The original complaint included two defendants, New York City Distributors of Pass and Legrand as defendants. According to the Plaintiff, after the suit was filed, and before Hubbell either served or notified the Distributors of the existence to the lawsuit, Hubbell learned that the Distributors, while

sellers of Pass' and Legrand's product line, did not yet have available the products at issue. Hubbell filed an amended complaint (the "complaint") which does not name the Distributors.

The complaint alleged three claims: 1) violation of § 32 of the Trademark Act of 1946, 15 U.S.C. § 1114; 2) violation of § 43(a) of the Trademark Act of 1946 and 3) violation of unfair competition under the common law of the State of New York.

Pass filed an answer on December 23, 1994, which included affirmative defenses and three counter claims. The counterclaims sought: 1) declaratory relief as the sales of connectors and plugs "out of the box"; 2) damages for intentional interference with business relationships; 3) cancellation of the Federal Trademark Registration for the designation "5965VY."

The Defendants' motions were filed in December 1994. Hubbell's motion was filed on January 13, 1995. All motions were argued on February 8, 1995. Defendants submitted a Supplemental Memorandum on May 15, 1995 and the motions were considered fully submitted at that time.

The Facts

For the last seventeen years Hubbell has sold various connectors and plugs in, what it terms, its "famous and highly distinctive 'Valise' Trade Dress, sales of these connectors and plugs have exceeded 33 million units and $50 million. The subject of this litigation is a particular connector and plug, which has been assigned the number 5965VY. This number appears on the connector. Hubbell claims that this number is a federally registered trademark of Hubbell.

The plug and connector had a design patent that has expired. There are no allegations that Defendants began to market their similar product prior to the expiration of the patent.

According to the complaint, the Defendants recently changed their line of plugs and connectors such that they are

"virtually indistinguishable" from the "famous" Hubbell Valise Trade dress. According to Hubbell, the Defendants further aggravated the situation by misappropriating Hubbell's federally registered trademark 5965VY, and applying it directly to the virtually indistinguishable product.

Discussion

Motions to Dismiss the Trade Dress Claims Are Denied

On a Rule 12(b)(6) motion to dismiss, the factual allegations of the complaint are presumed to be true and all factual inferences must be drawn in the plaintiffs' favor and against the defendants. *See Scheuer v. Rhodes,* 416 U.S. 232, 236, 94 S. Ct. 1683, 1686, 40 L. Ed.2d 90 (1974); *Cosmas v. Hassett,* 886 F.2d 8,11 (2d Cir. 1989); *Dwyer v. Regan,* 777 F.2d 825, 828-29 (2d Cir. 1985). Accordingly, the factual allegations set forth and considered herein are taken from the Plaintiff's Complaint and do not constitute findings of fact by the Court. They are presumed to be true only for the purpose of deciding the present motion to dismiss.

Rule 12(b)(6) imposes a substantial burden of proof upon the moving party. A court may not dismiss a complaint unless the movant demonstrates "beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief." *H.J., Inc. v. Northwestern Bell Tel. Co.,* 492 U.S. 229, 249-50, 109 S. Ct. 2893, 2905-06, 106 L. Ed.2d 195 (1989); *Hishon v. King & Spalding,* 467 U.S. 69, 73, 104 S. Ct. 2229, 2232-33, 81 L.Ed.2d 59 (1984); *Conley v. Gibson,* 355 U.S. 41, 45-46, 78 S. Ct. 99, 101-02, 2 L. Ed.2d 80 (1957).

Section 43(a)(1) of the Lanham Act, 15 U.S.C. § 1125(a)(1) protects trade dress from infringement when:

> [a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, and device, or any combination thereof, or any false designation of

> origin, false or misleading description of fact, or false or misleading representation of fact, which ——
>
> > (1)is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person....

15 U.S.C. § 1125(a).

The "trade dress" of a product consists of "its total image", composed of "features such as size, shape, color or color combinations, texture, [or] graphics." *Paddington Corp. v. Attiki Importers & Distribs.,* 996 F.2d 577, 582 (2d Cir. 1993), as quoted in *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 65, 70 (2d Cir. 1994). Such trade dress protection has been extended to product design and may include product configurations. *Le Sportsac, Inc. v. K Mart Corp.* 754 F.2d 71 (2d Cir. 1985.

As the Second Circuit has explained:

> To Prevail on a trade dress claim, the plaintiff must demonstrate that the product's appearance has acquired "secondary meaning" — the consuming public immediately identifies the product with its maker — and that purchasers are likely to confuse the imitating goods with the originals. Even if the plaintiff establishes these elements, the defendant may still avoid liability by demonstrating that the imitated features are "functional" — essential to the basic purposes the article is meant to serve. *Two Pesos, Inc. v. Taco Cabana, Inc., 112 S.Ct. 2753, 2760 (1992);* Coach Leatherware Co. v. Ann Taylor, Inc., 933 F.2d 162, 168 (2d Cir. 1991) (citations omitted).

Hubbell has alleged sufficient facts to make out the elements of a trade dress infringement claim. In count II of the Complaint Hubbell States:

> By its acts alleged herein, defendant has falsely designated the origin or sponsorship of its electrical connectors and plugs and has caused and will cause them to be advertised and sold in commerce, in violation of § 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a)

Complaint at § 23.

This Count is supported by the allegations of paragraphs 6-11 and 15-19 of the Amended Complaint (which must be taken as true for the purposes of this motion), which support (1) the inherently distinctive nature of the Valise Trade Dress; (2) sales, advertising, extent of use, and exclusivity sufficient to establish, as an alternative, the existence of secondary meaning in the Valise Trade Dress; and (3) intentional actions by Pass and Legrand in violation of these protectable rights likely to cause confusion among consumers. Pass has not challenged any of the specific allegations of the Complaint.

The Core issue raised by Defendants in seeking a motion to dismiss this complaint is that Hubbell is unlawfully seeking to extend expired patent monopolies for its plugs and connectors through the device of the Lanham Act.

The different purposes of the two sets of laws supports the position that trade dress protection is not as a matter of law unavailable to products for which design patents have expired.

The purpose of the federal design patent law is "to encourage the invention of ornamental designs". *In re Honeywell Inc.*, 497 F.2d 1344, 1348, *cert. denied,* 419 U.S. 1080 (1974; *see Lon Tai Shing Co. v. Koch and Lowy*, 19 USPQ.2d 1981 (S.D.N.Y. 1990).

More specifically, the Court in *Lon Tai Shing* explained that:

> More broadly viewed, the patent laws have three related purposes: "First, patent law seeks to foster and reward invention; second, it promotes disclosure of inventions, to stimulate further innovation and to permit the public to practice the invention once the patent expires; third, the stringent requirements for patent protection seek to assure that ideas in the public." *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979).
>
> This stands in clear contrast to the function of the trademark laws, particularly section 43(a) of the Lanham Act, which "seek[s] to prevent the public from encountering confusion, mistake, and deception in the purchase of goods and services and to protect the integrity of the trademark owner's product identity." *In re Honeywell, Inc.* 474 F.2d at 1348.

Lon Tai Shing, 19 USPQ.2d at 1106.

These two bodies of law were designed to serve quite different purposes and may operate separately and without unavoidable conflict. As noted by the *Long Tai Shing* Court 19 U.S.P.Q.2d at 1107, this point was underscored in the Supreme Court cases that represent the highwater mark of patent law supremacy — the so called *Sears-Compco* cases. *See Sears, Roebuck & Co. v. Stiffel Co.,* 376 U.S. 225 (1964); *Compco Corp. v. Day-Bright Lighting, Inc.,* 376 U.S. 225 (1964). In those decisions the Supreme Court held that the patent laws broadly preempt state trademark and unfair competition law insofar as it applies to industrial designs. Notwithstanding the breadth of the "Sears-Compco" cases ... the Supreme Court recently noted that:

> our decision in *Sears* clearly indicates that the States may place limited regulations on the circumstances in which such designs are used in order to prevent consumer confusion as to source. Thus while "Sears" speaks in absolutist terms, its conclusion that the States may place some conditions on the use of trade dress indicates an implicit recognition that all state regulations of potentially patentable but unpatented subject matter is not *ipso facto* preempted by the federal patent laws.

Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 154 (1989).

The Supreme Court cases cited by both parties and discussed above involved questions of federal preemption. The existence of the Lanham Act, a separate and equally viable body of federal law supports without reservation the notion that the two bodies of law can, an in fact that Congress intended them to, co-exist.

The Seventh Circuit addressed the issue presented in this case and concluded that "[c]ourts have consistently held that a product's different qualities can be protected simultaneously or successively, by more than one of the statutory means for protection of intellectual property." *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 638 (7th Cir. 1993). The Court continued:

> [F]ederal trademark protection does not transform the durational limited monopoly of a design patent into a perpetual right. As we have noted, federal trademark protection for a product's configuration does not create a monopoly in the use of the product's shape. [Plaintiff] is not "free from effective competition in the market..." [Plaintiff] simply has the right to preclude others from copying its trademarked product for the purpose of confusing the public as to its source.

29 U.S.P.Q. 2d at 1247-48, n.10 (emphasis in original); *see W.T. Rogers Co. v. Keene*, 778 F.2d 334 (7th Cir. 1985), recognizing the absolute distinction between the two types of protection (trade dress and design patent), Judge Posner reasoned:

> provided that a defense of functionality is recognized, there is no conflict with federal patent law, save possibly with 35 U.S.C. § 171, which allows a 14-year patent to be granted for a nonfunctional ornamental design — a design patent. But the courts that have considered the issue have concluded, rightly in our view, that this section does not prevent the enforcement of a common law trademark in a design feature. See discussion in 1 Chisum, Patents 185 1.04[6] (1985). The trademark owner has an indefinite term of protection, it is true, but in an infringement suit must also prove secondary meaning and likelihood of confusion, which the owner of a design patent need not do; there is therefore no necessary inconsistency between the two modes of protection.

Id. at 337.

The parties have not identified any case in this Circuit on this issue and the conclusion reached by the Seventh Circuit and by Magistrate Judge Michael H. Dolinger in this District in *Lon Tai Shing* is adopted.

In a different context, involving the ability to obtain trademark protection for a color, the Supreme Court recently noted that:

> It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited period of time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a products functional features could be used as trademarks,

> however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever... Functionality doctrine therefore would require, to take an imaginary example, that even if customers have come to identify the special i shape of a new patented light bulb with a particular manufacturer, the manufacturer may not use that shape as a trademark, for doing so, after the patent had expired, would impede competition — not by protecting the reputation of the original bulk maker, but by frustrating competitors' legitimate efforts to produce an equivalent i bulb. *See, e.g., Kellogg Co.,* ... 305 U.S., at 119-120...(trademark law cannot be used to extend monopoly over the "pillow" shape of shredded wheat biscuit after the patent for that shape had expired.

Qualitex Co. v. Jacobson Products Co., Inc., 115 S.Ct. 1300, 1304 (1995).

Defendants urge that this dicta in the *Qualitex* case should be considered by this Court. This may say no more than that patents related to function may not be protected past the duration of the patent.[1]

In any event, this language from the Supreme Court can be read to be consistent with the proposition that while Hubbell cannot assert trade dress claims to protect *in toto* the design which was protected by the earlier design patent, the expiration of the design patent does not preclude a party from seeking to protect its reputation or avoid consumer confusion over products if it can demonstrate the required elements of a Lanham Act, or other non-conflicting unfair competition, claim.

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1 The Supreme Court cited the Shredded Wheat case for this proposition. In that case however, the expired patent had been for the process that manufactured the "pillow shaped" wheat.

Again, the fact that the federal patent and trademark laws have co-existed for decades, provides support for the proposition that the protections offered by them can exist together now. *See supra.*

These claims will not now be dismissed as a matter of law.

A Sufficient Showing of Jurisdiction Has Been Made

In order to demonstrate personal jurisdiction sufficiently to defeat a motion to dismiss, a plaintiff need only make a *prima facie* showing that jurisdiction exists. *See Hoffritz for Cutlery, Inc. v. Amajac, Ltd.,* 763 F.2d 55, 57 (2d Cir. 1985). Plaintiff's complaint and affidavits are to be construed, and any doubts are to be resolved in the light most favorable to the Plaintiff. *Editorial Musical Latino Americana, S.A. v. Mar International Records, Inc.,* 829 F. Supp. 62, 64 (S.D.N.Y. 1993); *see also Scheuer v. Rhodes,,* 416 U.S. 232, 236, 94 S.Ct. 1683, 1686 (1974) (on motion to dismiss pleadings are considered in light most favorable to pleader).

The acts in the complaint attributed to "P&S" are, according to Plaintiff, attributed to both Pass and Legrand. This is not a case built on notions of piercing the corporate veil. The allegation is that Legrand has independently engaged in the same alleged wrongful behaviors. Legrand's motion to dismiss for lack of subject matter jurisdiction is denied.

To determine personal jurisdiction over a non-domiciliary in a federal question case, this Court applies the long-arm statute of the forum state. *See Business Trends Analysts v. Freedonia Group, Inc.,* 650 F.Supp. 1452, 1455 (S.D.N.Y. 1987); *United States v. First Nat'l City Bank,* 379 U.S. 378, 381 (1965).

New York's long-arm statute provides:

> As to a cause of action arising from any of the acts enumerated in this section, a court may exercise personal jurisdiction over any non-domiciliary, or his executor or administrator, who in person or through

> an agent; 1. transacts any business within the state or contracts anywhere to supply goods or services in the state; or 2. commits a tortious act within the state....

N.Y.Civ.Prac.L. & R. § 302(a) (McKinney 1993) ("CPLR § 302(a)").

Offering one copy of an infringing work for sale in New York, even if there is no actual sale, constitutes commission of a tortious act within the state sufficient to imbue this Court with personal jurisdiction over the infringers. "See Business Trends," 650 F. Supp. at 1455-56 (shipment of one copy into New York; actual sale not necessary); *Metropa Co. v. Choi* 458 F. Supp. 1052, 1054, (S.D.N.Y.1978) (trademark infringement; only New York contact of California defendant was mail order shipment of two wigs); *Honda Assocs., Inc. v. Nozawa Trading, Inc.,* 374 F. Supp. 886, 888-89 (S.D.N.Y.1974)(Trademark infringement, actual sale not necessary; only New York contact of California defendant was mail order shipment of 3 karate uniforms valued at $37). This Court has jurisdiction even if the products for sale are offered through independent brokers in New York. See CPLR 302(a) ("in person or through an agent"); *Heritage House Frame & Moulding Co. v. Boyce Highlands Furniture Co.,* 88 F.R.D. 172, 173 (E.D.N.Y. 1980).

Thus allegations that Legrand "has begun or is about to begin selling in ... this Judicial District the ... plugs and connectors ... [and] although [Legrand] has molded the name Pass & Seymour/Legrand into its infringing product, the name is indistinguishable except on extremely close examination" is sufficient to assert *prima facie* jurisdiction.

"While the plaintiff ultimately bears the burden of establishing the existence of jurisdiction over defendants by a preponderance of the evidence, the burden should not be imposed on the plaintiff at the pleading stage..."*Soviet Pan Am Travel Effort v. Travel Comm. Inc.,* 756 F. Supp. 126, 130 (S.D.N.Y. 1991). In the absence of an evidentiary hearing or further factual

development through discovery, the pleadings and affidavits must be construed in the light most favorable to the plaintiff. *Id.* At this stage of the proceedings, the motion is denied.

Motion to Dismiss for Improper Venue is Denied

Hubbell alleged venue in this case under 28 U.S.C. § 1391(c) which reads:

> For purposes of venue under this chapter, a defendant that is a corporation shall be deemed to reside in any judicial district in which it is subject to personal jurisdiction at the time the action is commenced. In a State which has more than one judicial district and in which a defendant that is a corporation is subject to personal jurisdiction at the time an action is commenced, such corporation shall be deemed to reside in any district in the State within which it contacts would be sufficient to subject it to personal jurisdiction if that district were a separate State, and, if there is no such district, the corporation shall be deemed to reside in the district within which it has the most significant contacts.

As the earlier discussion on personal jurisdiction implied. Pass is subject to personal jurisdiction in this District and thus venue as to the claims asserted against Pass is properly asserted in this District at this time. The same holds true for Letrand. Considering the pleadings before the Court, and given that neither party has plead the percentage of total sales in the District, all affidavits and pleadings are construed in the light most favorable to the Plaintiff and the motion to dismiss for lack of venue is denied on this record. *See Hoffritz,* 763 F.2d at 57; *Time Products v. Tira Classic Handbags, Inc.,* 1994 U.S.Dist. LEXIS 9483, *22 (S.D.N.Y. 1994).

In addition, venue over the claims against Legrand would be proper under § 1391(d).

Motion for Transfer is Denied at this Time

28 U.S.C. § 1404(a) provides:

> For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought.

Factors which determine whether a case should be transferred under § 1404 are: (1) the place where the operative facts occurred; (2) the convenience to parties; (3) the convenience of witnesses; (4) the relative ease of access to sources of proof; (5) the availability of process to compel attendance of unwilling witnesses; (6) the plaintiff's choice of forum; (7) the forum's familiarity with the governing law; and (8) trial efficiency and the interests of justice. *Viacom Intern. v. Melvin Simon Prods.*, 774 F. Supp. 858, 867-68 (S.D.N.Y. 1991); *Don King Prods., Inc. v. Douglas,* 735 F. Supp. 522, 533 (S.D.N.Y. 1990).

Plaintiff's choice of forum should not be disturbed unless Defendants make a clear and convincing showing that the balance of convenience favors defendants choice. *See Time Products,* at *33. A transfer should not be granted "absent a clear cut and convincing showing by defendant that the balance of convenience weighs strongly in favor of the transferee court...." *Star Lines, Ltd. v. Puerto Rico Maritime Shipping Auth.,* 442 F. Supp 1201, 1207 (S.D.N.Y. 1978).

The core determination under § 1404(a) is the center of gravity of the litigation, a key test of which is the convenience of witnesses. *Saminsky v. Occidental Petroleum Corp.* 373 F. Supp. 257 (S.D.N.Y. 1974); *Essex Crane Rental Corp. v. Vic Kirsch Const. Co.,* 486 F. Supp. 529 (S.D.N.Y.1980); 15 Wright, Miller & Cooper, *Federal practice & Procedure: Jurisdiction 2d* § 3851 (1986. Courts routinely transfer cases when the principal events occurred, and the principal witnesses are located, in another district. *Viacom Intern,* 774 F.Supp. at 868;

Computer Horizons Corp. v. Knauer 483 F. Supp. 1272 (S.D.N.Y. 1980).

While Pass has indicated that its corporate records and witnesses are in Syracuse,without further evidence of the proof required and the witnesses to be called, the balance of the evidence available at this time does not require the Court to disrupt the plaintiff's choice of forum. The motion to transfer is denied.

Plaintiff's Motion to Dismiss Pass' Counter Claim for Tortious Interference with Prospective Economic Advantage is Denied

To state a claim under this theory, the complaint must allege that defendant interfered with business relations existing between plaintiff and a third party, "either with the sole purpose of harming plaintiff or 'by means that are dishonest, unfair or in any other way improper.'" *Martin Ice Cream Co. v. Chipwich, Inc.,* (S.D.N.Y.1983) 554 F. Supp. 933, 945 (emphasis in original)(quoting *Robbins v. Ogden* (S.D.N.Y. 1980) 490 F.Supp. 801, 811). Where such interference is intended "'at least in part to advance the competing interest of the interferer' the interference will be excused unless the means employed include 'physical violence, fraud or misrepresentation, civil suits and criminal prosecutions and some degrees of economic pressure; they do not, however, include persuasion alone.'"*Strapex Corp. v. Metaverpa N.V.* (S.D.N.Y. 1985) 607 F.Supp. 1047, 1050 (*quoting Guard-Life Corp. v. S. Parker Hardware Mfg. Corp.* (1980) 50 N.Y.2d 183, 428 N.Y.S.2d 628, 632, 406 N.E.2d 445); *Volvo N. Am. v. Men's Int'l Professional Tennis Council* 857 F.2d 55, 74 (2d Cir. 1988).

According to the counterclaim, Pass has alleged that Hubbell "either investigated the allegations made in its initial Complaint and knew that the New York City distributors had not committed any of the alleged acts of infringement or unfair competition set forth in the [original] Complaint ... or, alternatively, ... failed to properly investigate adequately the allega-

tions...Despite the fact that Hubbell knew or should have known that the New York City Distributors should have known that the New York City Distributors have not purchased the plugs .... Hubbell filed its action naming the ... Distributors as defendants ... Hubbell's claims ... have injured the contractual and business relationships between the ... Distributors in that ... [they] have been improperly and falsely named as defendants.

The elements of the tort have been plead such that the motion to dismiss is denied.

Conclusion

For the reasons discussed above all motions are denied.

It is so ordered.

New York, N.Y.
May 18, 1995

(s)Robert W. Sweet
Robert W. Sweet
U.S.D.J.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

HUBBELL INCORPORATED,

Plaintiff

- against -

PASS & SEYMOUR, INC. and
LEGRAND, S.A.,

Defendants.

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In an opinion dated May 18, 1995 (the "Opinion"), this Court denied defendants Pass & Seymour, Inc. ("Pass"), and Legrand, S.A. ("Legrand") (Pass and Legrand are, collectively, the ("Defendants") motions to dismiss plaintiff Hubbell Incorporated's ("Hubbell") product configuration trade dress claims against Defendants. Defendants now move this Court to certify to the United States Circuit Court of Appeals for the Second Circuit, pursuant to 28 U.S.C. § 1292(b), the following question:

> whether the subject matter of an expired design and utility patent may form the basis for a later product configuration trade dress action.

For the reasons set forth below, Defendants' motion will be denied.

The Parties

Hubbell is a Connecticut corporation that manufactures electrical products. Its principal place of business is in Orange, Connecticut.

Pass is a New York corporation doing business in the State of New York and within this judicial district, having its principal place of business in Syracuse, New York.

Legrand is a corporation organized and existing under the laws of France.

Prior Proceedings

The prior proceedings and facts of this action are set forth in the Opinion, familiarity with which is presumed.

Defendants moved for amendment of the Opinion to allow for immediate certification of the product configuration trade dress issues of law in this action to the United States Circuit Court of Appeals for the Second Circuit. Oral argument on Defendants' motion was heard on June 21, 1995. Additional papers were submitted by the parties, the last of which was

received on July 21, 1995, and the motion was deemed fully submitted at that time.

Discussion

28 U.S.C. § 1292(b) provides that a district court may certify an order for appeal if it concludes (1) that the order involves a controlling question of law (2) as to which there are substantial grounds for difference of opinion and (3) that an immediate appeal from the order may materially advance the ultimate termination of the litigation 28 U.S.C. § 1292(b): "see also Klinghoffer v. S.N.C. Achille Lauro Ed Altri-Gestione Motonave Achille Lauro In Amministrazions Straordinaria 921 F.2d 21, 23 (2d Cir. 1990). The Second Circuit has repeatedly "urged the district courts to exercise great care in making a § 1292(b) certification." *Westwood Pharmaceuticals, Inc. v. National Fuel Gas Dist. Corp.*, 964 F.2d 85, 89 (2d Cir. 1992). Certification is limited to extraordinary cases where appellate review might avoid protracted and expensive litigation. It is not intended as a vehicle to provide early review of difficult rulings in hard cases. *Sadowski v. Technical Career Inst., Inc.*, 1955 U.S. Dist LEXIS 3184, *7; *Abortion Rights Mobilization, Inc. v. Regan*, 522 F.Supp. 364, 366 (S.D.N.Y. 1982).

This standard is not met here. As an initial matter, this Court notes that Hubbell maintains that certain unpatented features of its product's configuration, e.g., its yellow color, are part of its distinctive trade dress. Therefore, even if this Court were to certify to the Second Circuit the question whether the subject matter of an expired design patent can receive trade dress protection, the Second Circuit's answer to that question would neither "control" the outcome nor "materially advance the ultimate termination" of this litigation. Even assuming, however, that the Second Circuit's answer would control the outcome and advance the termination of this litigation, there are not "substantial grounds for difference of opinion" as to this Court's resolution of the product configuration trade dress issue.

The parties agree that the precise question at issue in this case has not yet been considered by either the Supreme Court or the Second Circuit. Simply because a question of law has not been authoritatively addressed, however, does not make the question grounds for a substantial difference of opinion. *Chamarac Properties, Inc. v. Pike,* 1994 WL 410902, *2 (S.D.N.Y. 1994); *American Tel. & Tel. Co. v. North American Industries, Inc.,* 783 F.Supp. 810, 814 (S.D.N.Y. 1992). Nor, for that matter, does the fact that the parties themselves disagree as to the interpretation of persuasive authority constitute a "difference of opinion" sufficient to warrant certification. Thus, the fact that the parties offer differing interpretations of dicta in the Second Circuit's recent decision in *Milstein, Inc. v. Greger, Lawlor, Roth, Inc.,* 1995 WL 380952 (S.D.N.Y. June 19, 1995) does not compel certification of the question presented in the instant case. *Milstein* was decided after the Opinion at issue in this motion.

In "Milstein", the Second Circuit noted that:

> although trade dress law may supplement copyright and patent law by protecting unpatentable product configurations and novel marketing techniques,...overextension of trade dress protection can undermine restrictions in copyright and patent law that are designed to avoid monopolization of products and ideas. Consequently, courts should proceed with caution in assessing claims to unregistered trade dress protection so as not to undermine the objectives to these other laws.

Hubbell interprets this language to mean that the existence, or past existence, or patent protection does not preclude trade dress protection of the same subject matter. Defendants, on the other hand, interpret this language to mean that trade dress law which extends protection to patentable subject matter is a *per se* "overextension of trade dress protection" which serves to "un-

dermine restrictions in copyright and patent law that are designed to avoid monopolization of products and ideas." Both of these interpretations exceed the limits of what the quoted language will bear.

The most that can be inferred from the language quoted above is that the Second Circuit has recognized that the patent and trade dress laws serve different objectives. This observation, however, is neither novel nor controversial. As this Court observed in the Opinion, the patent laws seek to foster and reward innovation, promote disclosure of inventions to the public after the patent has expired, and ensure that ideas in the public domain remain there for the free use of the public. *Aronson v. Quick Point Pencil Co.,* 440 U.S. 257, 262 (1979). The trademark laws, in contrast, seek to protect the public from experiencing confusion, mistake and deception in the purchase of goods and services and to protect the integrity of the trademark owner's product identity. *See Park 'N Fly, Inc. v. Dollar Park and Fly* 469 U.S. 189, 198 (1985); *Lon Tai Shing Co. v. Koch & Lowwy,* 19 USPQ.2d 1981, 1107 (S.D.N.Y. 1990).

The part of the quoted language that admonishes district courts to "proceed with caution in addressing claims to unregistered trade dress protection" can be interpreted only as advocating a careful case by case approach in order to ensure that the objectives of the patent law are not undermined by extending protection to a product's trade dress *See also Stormy Clime Ltd. v. ProGroup, Inc.,* 809 F.2d 971, 978 (2d Cir. 1987) ("To avoid undermining the purpose of the patent laws to place useful innovations in the public domain after expiration of a limited monopoly, courts must be sensitive to whether a grant of trade dress protection would close all avenues to a market that is otherwise open in the absence of a valid patent.")

The Court in *Milstein" was concerned that a manufacturer of greeting cards would gain a monopoly on a distinctive type of greeting card by claiming that the distinctive features of that*

type are part of its protected trade dress. Because the plaintiff in "Milstein" had never owned a patent on the process for creating the type of greeting card, the Court did not have reason to consider whether prior protection under a design patent precludes protection of the same design features under the trade dress laws. Nothing in the language quoted above, however, or any other language in "Milstein," indicates that a court may not extend trade dress protection to a previously patented design feature if it determines, after cautious deliberation, that extending such protection will serve the objectives of the trade dress laws without doing violence to the objectives of the patent laws.

Defendants also assert that, in light of its holding in "Milstein," the Second Circuit, if presented with similar case would endorse the Tenth Circuit's recent decision in *Vornado Air Circulation Sys. v. Duracraft Corp.*, 1995, U.S. App. LEXIS 16255 (10th Cir. 1995). Even assuming that hypothesis to be true, however, the Tenth Circuit's holding *Vornado* does not support the grant of a motion to dismiss on the facts of the instant case.

As an initial matter, it should be noted that the question presented in *Vornado* was whether the subject matter of an expired *utility* patent could receive trade dress protection. The Court did not take a position, therefore, on whether its ruling applies equally to *design* patents. Even if this Court were to adopt the holding of *Vornamdo* with respect to *design* patents, however, dismissal of Hubbell's complaint on a Rule 12(b)(6) motion would be inappropriate. In *Vornado*, the Court held that:

> although a product configuration must be nonfunctional in order to be protected as trade dress under section 43(a), not every nonfunctional configuration is eligible for that protection. Where a product configuration is a significant inventive component of an invention covered by a utility patent, so that without it the invention cannot fairly be said to be the same

> invention, patent policy dictates that it enter into the public domain when the utility patents...expire. To ensure that result, it cannot receive trade dress protection under section 43(a).
>
> 1995 U.S. App. LEXIS 16255 at *3

Implicit in the above quoted language is the idea that, although "not every nonfunctional configuration is eligible for [trade dress] protection," some nonfunctional configurations *are* so eligible. Defendants have made no definitive showing that the product configuration for which Hubbell seeks trade dress protection is a "significant inventive component" of the invention covered by Hubbell's patent, "so that without it the invention cannot fairly be said to be the same invention." The Tenth Circuit's implicit suggestion that trade dress protection is not precluded if a product's configuration was not a "significant inventive component" of the patented invention calls for the same cautious, case by case approach urged by the Second Circuit in *Milstein Inc. v. Greger, Lawlor, Roth, Inc.,* 1995 WL 380952 (S.D.N.Y. 1995). Indeed the *Vornado* Court noted that:

> In future cases, the contribution of a particular configuration to the inventiveness of a patented product may not always be clear, and we do not wish to rule out the possibility that a court may appropriately conduct a factual inquiry to supplement its reading of the patent's claims and descriptions.
>
> 1995 U.S. App. LEXIS 16255 at *39.

Whether or not it would endorse the holding of *Vornado*, the Second Circuit's recommendation in *Milstein* of a careful balancing of the separate purposes of patent and trademark law requires a fully disclosed factual record, which was not available to the Court at the time the Opinion was issued, nor is it now. Moreover, Defendants have not addressed the point, raised in the Opinion, that while Hubbell cannot assert trade dress claims to protect in toto the design which was protected by its design

patent, the expiration of that patent does not preclude Hubbell from seeking to protect its reputation or avoid consumer confusion over its products if it can demonstrate the required elements of a Lanham Act or other non-conflicting unfair competition claim.

In the Opinion, this court concluded that the objectives of the trade dress laws will be served, and the objectives of patent laws will not be undermined, by permitting Hubbell's trade address claims to survive Defendants' motion to dismiss. Hubbell carries the ultimate burden, however, of showing either that its product's trade dress is inherently distinctive, *Two Pesos, Inc. v. Taco Cabana, Inc.,* 112 S.Ct. 2753 (1992), or, if the trade dress is not inherently distinctive, that it "has acquired a secondary meaning— that is, the trade dress identifies the source of the product— and that there is a likelihood of confusion between the original trade dress and the trade dress of the allegedly infringing product." *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.,* 916 F.2d 76, 79 (2d Cir. 1990), *cert. denied,* 111 S.Ct 1622 (1991).

For the purposes of resolving Defendants' motion to dismiss, the Court did not examine the sufficiency of Hubbell's showings under the above standards. Instead, the Court confined its inquiry to the availability *vel non* of trade dress protection for the subject matter of expired design patents. The Court's resolution of the question Defendants seek to certify to the Second Circuit does not lessen Hubbell's substantive burdens at trial or, indeed, the burdens it would have to carry to withstand a motion for summary judgment. Hubbell has, however, alleged facts sufficient to withstand the instant motion to dismiss.

Conclusion

For all the reasons stated above, Defendants' motion to certify the product configuration trade dress issues of law in this action to the United States Circuit Court of Appeals of the Second Circuit is denied.

It is so ordered.

New York, N. Y.

August 3, 1995

/s/ Robert W. Sweet
ROBERT W. SWEET
U.S.D.J.